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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/421,635	10/19/1999	MARK A. REILEY	1759.16690	4414
26308	7590	03/24/2004	EXAMINER	
RYAN KROMHOLZ & MANION, S.C. POST OFFICE BOX 26618 MILWAUKEE, WI 53226			MAYNARD, JENNIFER J	
		ART UNIT	PAPER NUMBER	
		3763	ZD	

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/421,635	REILEY
Examiner	Art Unit	
Jennifer J Maynard	3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 02 January 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 46-56 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 46-56 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date .

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_ .

**DETAILED ACTION**

*Response to Amendment*

*Claim Rejections - 35 USC § 102*

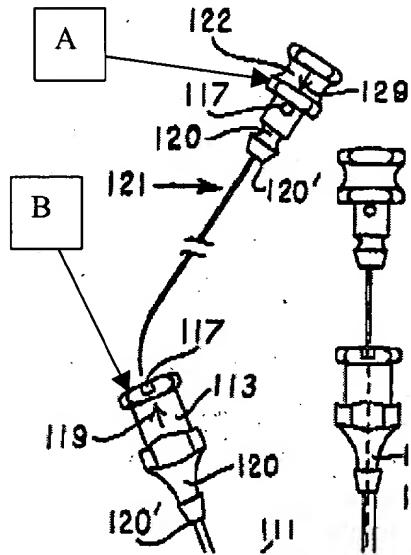
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 46-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Woo (US 3,943,932 A).

Woo (US 3,943,932 A) discloses a needle device comprising a first functional instrument (21, 121) including a first handle (22, 122) having a first marker (129), the first handle including a first finger gripping surface (A, see labeled figure on the top of the next page), and a second functional instrument (11, 111) including a second handle (13, 113) having a second marker (19, 119), the second handle including a second finger gripping surface (B, see labeled figure on the top of the next page). The first functional instrument engaging the second functional instrument, forming a composite handle, see Figure 3, the first handle mating the second handle when the first functional instrument is engaged with the second functional instrument forming a composite handle, whereby the first gripping surface and the second gripping surface fit together to form a composite finger gripping surface that includes the first and second finger gripping surfaces.



*Claim Rejections - 35 USC § 103*

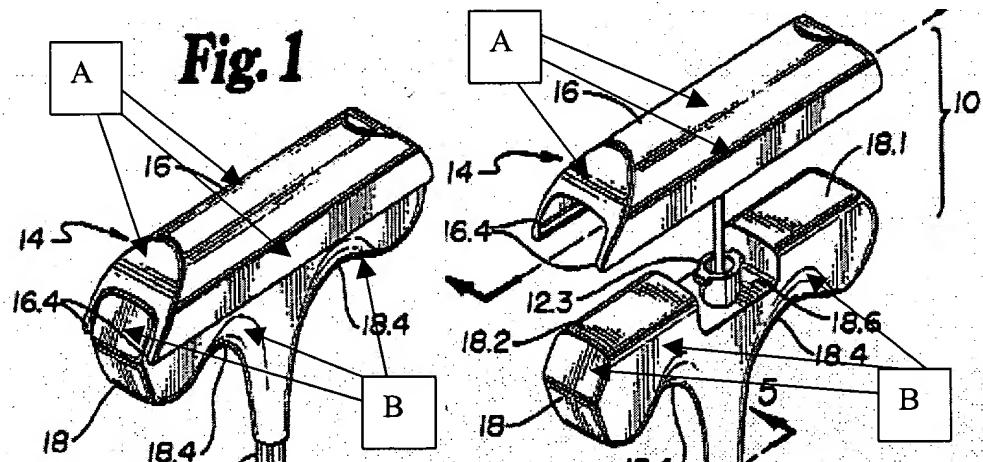
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 46-56 are rejected under 35 U.S.C. 103(a) as obvious over Strasser et al. (US 4,838,282 A) in view of Woo (US 3,943,932 A).

Strasser et al. disclose a tool comprising a first functional instrument (14) including a first handle (16) with a first finger gripping surface (A, see labeled figure on next page, interpreted as any surface which would be engaged by the user's fingers), and a second functional instrument (12) including a second handle (18) with a second finger gripping surface (B, see labeled figure below on next page, interpreted as any surface which would be engaged by the user's fingers).

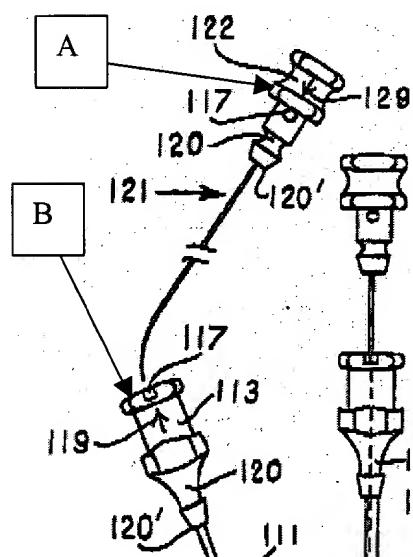
The first functional instrument engaging the second functional instrument, forming a composite handle, see Figure 1, the first handle mating the second handle when the first functional instrument is engaged with the second functional instrument forming a composite handle, whereby the first gripping surface and the second gripping surface fit together to form a composite finger gripping surface that includes the first and second finger gripping surfaces. Strasser et al.'s composite handle is constructed from a thermoplastic molding material known as Cycolac (ABS), which resists deformation when a striking force is applied. When the composite handle is formed, as shown in Figure 1, the two individual gripping surfaces of the individual handles together form a larger composite gripping surface.



Strasser et al. fails to disclose a first marker on the first handle and a second marker on the second handle, which are located in a pre-determined visual alignment when the composite handle is formed.

Woo (US 3,943,932 A) discloses a needle device comprising a first functional instrument (21, 121) including a first handle (22, 122) having a first marker (129), the first handle including a first finger gripping surface (A), and a second functional instrument (11, 111) including a

second handle (13, 113) having a second marker (19, 119), the second handle including a second finger gripping surface (B). The first functional instrument engaging the second functional instrument, forming a composite handle, see Figure 3, the first handle mating the second handle when the first functional instrument is engaged with the second functional instrument forming a composite handle, whereby the first gripping surface and the second gripping surface fit together to form a composite finger gripping surface that includes the first and second finger gripping surfaces.



It would have been obvious to one having ordinary skill in the art to have utilized a die-cut type marker on the handle portions of Strasser et al., as taught by Woo, so as to provide an alternative mechanism for providing visual indication of the alignment of the tips of the instruments relative to one another during insertion, as Strasser et al. stresses the importance of proper bevel alignment. Additionally, it would have been obvious to one having ordinary skill in the art to have placed the respective markers on one side of the two handle portions' surfaces, as

the structural engagement of the two handle portions inherently creates a flush composite handle, and further this location of the markers would ensure that the alignment of the markers would be visible by a user looking down on the composite handle as this would provide the most easily viewed site for the point of reference most often relied upon by the user.

***Response to Arguments***

Applicant's arguments filed 02 January 2004 have been considered but are moot in view of the new grounds of rejection with respect to Woo (US 3,943,932 A).

Applicant's arguments filed 02 January 2004 have been fully considered but they are not persuasive. Applicant's arguments have been addressed in the above made rejection with respect to Strasser et al. (US 4,838,282 A) in view of Woo (US 3,943,932 A).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer J Maynard whose telephone number is 703.305.1356. The examiner can normally be reached on Mondays-Fridays 9:30 AM-5:30 PM; 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 703.308.3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J Maynard



BRIAN L. CASLER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700